

Appl. No. 10/719,786  
Docket No. 9431  
Amdt. dated 6 December 2006  
Reply to Office Action mailed on August 10, 2006  
Customer No. 27752

## REMARKS

### Claim Status

Claims 5-7, 9-11, 13, and 18-20 are pending in the present application. No additional claims fee is believed to be due.

Claim 14 has been canceled without prejudice.

Claim 13 has been amended include the word "depressions" and remove the word "grooves". Support for this is on page 7, lines 6 and 7 of the Specification. Additionally, the following underlined language has been added, "depressions having at least one shape, wherein said at least one shape is selected from the group consisting of ovals, circles, rectangles, trapezoids, triangles, cones, squares, spirally shaped, rectangles, quadrilaterals, pentagons, hexagons, heptagons, octagons, nonagons, decagons, parallelograms, rhombuses, trapeziums, alphanumeric, animal shapes, trademarks, logos, foreign languages, kanji, ASCII, and mixtures thereof". Support for this is on page 7, lines 10-15 of the Specification. Further, the following language has been removed from claim 13, "wherein said grooves have a length less than 5 mm" and "surface aberrations".

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

### Rejection Under 35 USC §112 First Paragraph

The Office Action States that claims 5-7, 9-11, 13, 14, and 18-20 have been rejected under 35 U.S.C. §112 first paragraph, for failing to comply with the written description requirement. Claim 13 recites the combination of both grooves on the outer portion of the insertion end. It is stated in the Office Action of 10 August 2006, that there is no single embodiment in the Specification, Drawings, or the Claims as originally filed that supports such an embodiment. Figures 1-3 show an embodiment with protuberances only, while figures 4-7 show embodiments with grooves only. Applicant neither agrees nor disagrees with the rejection contained in the Office Action of 10 August 2006.

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However, in the spirit of compact prosecution Applicant has removed the word "grooves" from claim 13 and added the word "depressions". As such, Applicant respectfully submits that claims 5-7, 9-11, 13, and 18-20, meet the written description requirement of the first paragraph of 35 U.S.C. §112.

Rejection Under 35 U.S.C. §103(a) Over Schoelling (U.S. 2001/0014348) in view of  
Policappelli (U.S. 7,060,057)

Claims 5-7, 9-11, 13, 14, 18, and 19 have been rejected under 35 USC §103(a) as being unpatentable over Schoelling in view of Policappelli.

With respect to claims 5-7, 9-11, 13, 18, and 19 and obviousness: Applicant respectfully traverses the rejection, as the cited references do not establish a *prima facie* case of obviousness. As stated in the MPEP §2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

1. No suggestion or motivation to modify Schoelling in light of reference teachings

Applicant submits that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Schoelling or to combine the reference teachings to achieve the claimed invention.

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Schoelling discloses a tampon, which is designed to control the tampon's absorbency and expandability without additional preparation expenses and costs. (Page 1, Paragraph 0004) The tampon 10 is substantially enclosed within a cover 22 comprising fluid impervious plastic material in the form of a resilient three-dimensional web having perforations 24. (Page 1, Paragraph 0014) As mentioned above and noted in the Office Action, Schoelling does not disclose or suggest a tampon, wherein a measured portion of the outer surface of the insertion end comprises a first surface area and a measured portion of the outer surface of the withdrawal end comprises a second surface area, said first surface area being different than said second surface area, wherein at least a portion of said first surface area comprises depressions having at least one shape, wherein said at least one shape is selected from the group consisting of ovals, circles, rectangles, trapezoids, triangles, cones, squares, spirally shaped, rectangles, quadrilaterals, pentagons, hexagons, heptagons, octagons, nonagons, decagons, parallelograms, rhombuses, trapeziums, alphanumeric, animal shapes, trademarks, logos, foreign languages, kanji, ASCII, and mixtures thereof, wherein at least a portion of said first surface area further comprises protuberances.

Policappelli discloses a tampon that has non-absorptive members spaced on the outside surface of the absorptive member, and which protrude outwardly from the surface of the absorptive member. The orientation of the non-absorptive members effectively permits the walls of the vagina, which would otherwise normally be in contact with the absorptive member, to only have an interaction with the non-absorptive members. (Col. 2, Lines 3-19 and Col. 4, Lines 12-20)

There is no disclosure in Schoelling of the benefit or desire to modify its cover to contain protuberances. Schoelling's invention is concerned with the use of perforations in a fluid impervious plastic tampon cover. The perforations in the cover serve to manage the expansion of a tampon by controlling the amount of bodily fluids absorbed along the length of the tampon. (Page 1, Paragraph 0014) There is no indication in Schoelling that the addition of non-absorptive members (protuberances) to the perforations in its cover

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would have any effect, much less a positive effect on the ability of the cover to control absorption and expansion of the core.

Furthermore, even though Policappelli teaches a tampon with members, the members are used in a manner that teaches nothing to the skilled person viewing Schoelling. As discussed above Schoelling teaches a tampon for the controlled absorption of bodily fluids, and Policappelli teaches a tampon that uses non-absorptive members, to prevent the vaginal wall from contacting the absorptive part of the tampon. Therefore, how can Policappelli motivate one of ordinary skill in the art, to combine its non-absorptive members with the tampon disclosed in Schoelling when Policappelli does not teach, that the protuberances of a tampon can be used to absorb bodily fluids, or that non-absorptive protuberances have any effect on the control of absorption of bodily fluids by the absorbent core?

Accordingly, Applicant respectfully submits that there is no motivation to combine Schoelling with the teachings of Policappelli.

## 2. No reasonable expectation of success

The invention is directed to a tampon for feminine hygiene comprising an outer surface; wherein a measured portion of said outer surface of said insertion end comprises a first surface area and a measured portion of said outer surface of said withdrawal end comprises a second surface area, wherein at least a portion of said first surface area comprises depressions having at least one shape, wherein said at least one shape is selected from the group consisting of ovals, circles, rectangles, trapezoids, triangles, cones, squares, spirally shaped, rectangles, quadrilaterals, pentagons, hexagons, heptagons, octagons, nonagons, decagons, parallelograms, rhombuses, trapeziums, alphanumeric, animal shapes, trademarks, logos, foreign languages, kanji, ASCII, and mixtures thereof, wherein at least a portion of said first surface area further comprises protuberances.

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Neither reference discloses that protuberances can be used on a tampon's surface to absorb bodily fluids. (Spec. Page 7, Lines 1-5) Rather, the perforations in the fluid impervious plastic cover of Schoelling are used to control fluid absorption into the absorbent core, and the members of Policappelli are non-absorptive, and used to prevent the vaginal wall from contacting the absorptive part of the tampon.

Accordingly, Applicant submits that there is no reasonable expectation of success in achieving the present invention by combining (or attempting to combine) the perforated liquid impervious outer cover of Schoelling with the non-absorptive members of Policappelli.

For the reasons above, Applicant respectfully submits that the Office Action fails to make out a *prima facie* case of obviousness for claims 5-7, 9-11, 13, 18 and 19.

Rejection Under 35 U.S.C. §103(a) Over Schoelling (U.S. 2001/0014348) and  
Policappelli (U.S. 7,060,057) in view of Child et al. (U.S. 6,283,952)

Claim 20 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Schoelling and Policappelli as applied to claims 5-7, 9-11, 13, 14, 18 and 19, in view of Child et al.

With respect to claim 20 and obviousness: Applicants respectfully traverse the rejection, as neither alone, nor in combination do the Schoelling and Policappelli references make the present invention obvious, for the reasons stated above in regard to the rejection of claims 5-7, 9-11, 13, and 18 and 19. The addition of Child et al. to the combination of Schoelling and Policappelli does not remedy this deficiency.

Accordingly, Applicant respectfully submits that claim 20 is non-obvious in view of Schoelling, Policappelli and Childs et al.

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Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §103(a). Early and favorable action in the case is respectfully requested.

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 5-7, 9-11, 13, and 18-20 is respectfully requested.

Respectfully submitted,

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Date: 6 December 2006

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